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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/078,768	06/16/93	TULLIS	R PMB9658

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EXAMINER	
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ART UNIT	PAPER NUMBER
1804	40
DATE MAILED:	

08/21/95

Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☐ THE PERIOD FOR RESPONSE:

- a) ☐ is extended to run _____ or continues to run _____ from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 07/20/95 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
 - b. ☐ They raise new issues that would require further consideration and/or search. (See Note).
 - c. ☐ They raise the issue of new matter. (See Note).
 - d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☐ will not be entered and the status of the claims ☒ as follows:

Claims allowed: None.
Claims objected to: None.
Claims rejected: 64-72.

However;

☐ Applicant's response has overcome the following rejection(s): _____

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because see pages 2-3.

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

- ☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.
- ☐ Other

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The rejection stands for reasons already of record.

Applicant filed a request for reconsideration on July 20, 1995 in connection with claim 71 only, which claim is directed to a method of inhibiting expression by using nuclease resistant oligonucleotides as antisense agents. Applicant continues to argue that those of skill in the art would know which oligonucleotides to use as antisense agents given the instant disclosure. However, it cannot be agreed that the scant statements in the application (e.g., at page 4) in regard to the use of stabilized forms of oligonucleotides are in any way adequate direction for those of skill in the art as is required under the statute. Indeed, applicant's strenuous argumentation to the effect that those of skill in the art would be expected to do literature searches and would be led from the work of one researcher to another and would see that work on a background of hypothetical information that is only speculated at (e.g., see points 3, 4, and 5 on page 5 of the response filed July 20, 1995) all support the notion that the specification does not teach those of skill in the art how to make and use the invention. This is the standard of the statute and this is what is expected of the application. It is not enough to hint at what may be desirable, expecting those of skill in the art to perform the undue experimentation that is required to make the invention work. Finally, it is noted that point 6 on page 5 of the response filed July 20, 1995 is not an objective reason, but is an opinion; in fact, it is an opinion unsupported by objective evidence in the record.

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Art Unit 1804

Certain papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Art Unit 1804 at (703) 308-4312. The faxing of such papers must conform with the rules published in the Official Gazette, 1156 OG 61 (November 16, 1993).

Any inquiry concerning this communication should be directed to J. Martinell at telephone number (703) 308-0296.


JAMES MARTINELL, PH.D.
SENIOR LEVEL EXAMINER
GROUP 1800

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